

Application Serial No. 10/574,169
Amendment dated October 5, 2010
Response to Office Action dated July 7, 2010

REMARKS

The Office Action Summary for the Office Action of July 7, 2010 says that the office action is non-final. PAIR also identifies the Office Action as being non-final. However, page 8 of this Office Action states that "This Action is made Final." Because the Examiner cited new art and entered a new ground of rejection, the office action cannot be made final and the statement in the Office Action Summary is correct and the Office Action is a non-final Office Action.

As may be appreciated from the above listing of claims, the claims have been amended herein. Support for the amendments to the claims made herein may be found at least at pages 10-11 of the Specification. The present amendment includes new claims 30-33. The fee for the examination of these additional claims is included with this Amendment. Authorization is also provided herewith to pay any underpayment of fees or credit any overpayment of fees to Deposit Account No. 02-4800.

In page 2 of the Office Action of July 7, 2010, the Examiner provided comments regarding the pending claims. Applicants thank the Examiner for those comments. It is believed that these comments helped expedite examination of this application. The presentation of new claims 30-33 made herein were made in view of the Examiner's comments made in the Office Action.

I. RESPONSE TO REJECTION OF CLAIMS UNDER 35 U.S.C. § 103

Claims 9-11, 13-16 and 18-29 were rejected as obvious in view of U.S. patent No. 7,062,480 to Fay et al. and U.S. Patent Application Publication No. 2006/0020686 to Liss et al. in the Office Action of July 7, 2010 (hereafter "Office Action"). (Office Action at 3-6).

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Applicants noted that the Examiner's rationale for the rejection of the claims utilizes this cited art, but that summary paragraphs use different references that were previously cited by the Examiner. Applicants believe the summary on page 3 identifying the Jung and Shrivastava references is a typo and have responded to the art relied upon by the Examiner to substantiate the rejection of the pending claims.

Claim 12 was rejected in view of Fay et al., Liss et al. and U.S. Patent Application Publication No. 2002/0016964 to Aratani et al. (Office Action, at 6). In the Office Action, he Examiner identifies a Chen reference that includes a U.S. published patent application number, 2002/016964 as being this reference. However, Applicants were unable to locate such a reference with this publication number. It is believed the Examiner made a typographical error with respect to the identification of this reference in the Office Action and intended to refer to the Aratani et al. reference.

Claims 20 and 26 were rejected as obvious in view of Fay et al., Liss et al., and U.S. Patent Application Publication No. 2004/0111492 to Nakahara. (Office Action, at 7). Applicants note that the rejection of claims 12, 20 and 26 utilize summaries that identify the new art relied upon by the Examiner to reject the pending claims, but also include some discussion of previously cited art. Applicants believe the references to previously relied upon art by the Examiner were typographical errors made by the Examiner in issuing the Office Action.

A. Burden Of Proving Obviousness Under 35 U.S.C. § 103

"**All words in a claim must be considered in judging the patentability of that claim against the prior art.**" MPEP § 2143.03 (emphasis added). "When evaluating claims for obviousness under 35 U.S.C. 103, **all the limitations of the claims must be considered and**

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given weight." MPEP § 2143.03. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *Id.* "A 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date." MPEP § 2141.01.

To establish a *prima facie* case of obviousness, an Examiner must show that an invention would have been obvious to a person of ordinary skill in the art at the time of the invention. MPEP § 2141. "Obviousness is a question of law based on underlying factual inquiries." *Id.* The factual inquiries enunciated by the Court include "ascertaining the differences between the claimed invention and the prior art" and "resolving the level of ordinary skill in the pertinent art." MPEP § 2141.

"A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art' at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." MPEP § 2143.01. "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, **there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.**" MPEP § 2143.01 (citing *KSR*, 82 USPQ2d at 1396) (emphasis added).

For instance, an invention that permits the omission of necessary features and a retention of their function is an indicia of nonobviousness. *In re Edge*, 359 F.2d 896, 149 U.S.P.Q. 556 (CCPA 1966); MPEP 2144.04. A conclusory statement to the contrary is insufficient to rebut such an indicia of nonobviousness. *See* MPEP § 2143.01.

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Moreover, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." MPEP § 2143.01. Also, "the proposed modification cannot render the prior art unsatisfactory for its intended purpose." MPEP § 2143.01.

B. Claims 9-15 And Claims 19-23 Are Not Rendered Obvious By The Cited Art

Claim 9 requires a method for verifying an availability of a server to include transmitting a message regarding an availability of the server by a first client to a plurality of predefinable other clients and preventing the transmission of any availability request by the predefinable other clients to the server for at least a prescribable period of time. Claims 10-15 and 19-23 depend directly or indirectly from claim 9 and, therefore, also contain these limitations.

None of the cited art teaches or suggests all of the limitations of claims 9-15 or 19-23. As the Examiner correctly acknowledges in the Office Action, the Fay et al. reference alone does not teach or suggest all the limitations of the claims, which is why the Examiner also cited the Liss et al. reference. However, the Liss et al. is not a prior art reference. Therefore, there is no combination of prior art cited by the Examiner that teaches or suggests all the limitations of the pending claims.

1. The Liss et al. Reference Is Not Prior Art

The filing date for the Liss et al. reference is July 22, 2004. The priority date for the present application is September 30, 2003, which is almost a year prior to the date of invention for the Liss et al. reference. Further, the present application was filed as a PCT application on September 14, 2004, well before the January 26, 2006 publication date for the Liss et al.

reference. The Liss et al. reference therefore is not prior art. 35 U.S.C. § 102(e); MPEP § 706.02(f)(1).

Alone or in any combination, none of the cited art that is actually prior art to the pending claims teaches or suggests all the limitations of claims 9-15 and 19-23.

C. Claims 18 And 24-29 Are Allowable

Claim 16 requires a control program loaded into a RAM of a client to have code that causes the client to transmit a message regarding an availability of the server to a plurality of other clients. This message is configured to prevent transmission of availability requests by predefinable other clients to the server for a predefinable period of time.

Claim 18 requires a client to include a device configured to transmit a message regarding an availability of the server to a plurality of predefinable other clients. This message is configured to prevent a transmission of an availability request by any of the predefinable other clients to the server for a predefinable period of time if the confirmation message responding to the availability request is received by the client. Claims 24-29 depend directly or indirectly from claim 18 and also include these limitations.

As noted above, the combination of Fay et al. and Liss et al. is not able to render the pending claims obvious. Liss et al. is not prior art to the pending claims. MPEP § 706.02(f)(1). As the Examiner correctly acknowledges in the Office Action, Fay et al. alone does not teach or suggest all the limitations of the pending claims. Alone or in any combination, none of the cited art that is actually prior art to the pending claims teaches or suggests all the limitations of claims 18 and 24-29.

D. New Claims 30-33 Are Allowable

Claim 30 is directed to a method for verifying an availability of a server. The method includes checking for a receipt of a message regarding a transmission of a server keepalive test by a first client within a first predetermined period of time. If no message regarding the transmission of the keepalive test is received by the first client within the first predetermined period of time, the first client transmits a message regarding a collective request to a plurality of predefineable other clients. The first client also transmits an availability request to the server. The availability request sent to the server comprises data of the predefineable other clients that responded to the message regarding the collective requests within a second predetermined period of time. The transmission of any availability requests by the plurality of predefinable other clients to the server is also prevented for at least a prescribable period of time. After a third predetermined period of time or after receipt of a response to the availability request sent to the server, the first client transmitting a message regarding an availability of the server to the predefinable other clients that responded to the message regarding the collective requests within the second predetermined period of time. Claims 31-33 depend directly or indirectly from claim 30 and, therefore, also contain these limitations.

None of the cited prior art teaches or suggest the limitations of claims 30-33. For instance, Fay et al. do not teach or suggest any client that send any availability request to a server that comprises data of predefineable other clients that responded to a message regarding collective requests within a predetermined period of time.

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E. Granted European Patent No. EP 1 668 866 Is An Indicia Of Nonobviousness

EP 1 668 866 is a European patent that is related to the present application. The European Patent Office reviewed the prior art and found that the application submitted by applicant warranted patent protection and granted a patent to the assignee of the present application that contained claims having a similar scope to the claims presented herein. A copy of this patent was provided to the Examiner with the Amendment dated July 8, 2009.

For at least the above discussed reasons, the pending claims are not rendered obvious by the cited art. Reconsideration and allowance of these claims is respectfully requested.

III. CONCLUSION

For at least the above reasons, reconsideration and allowance of all pending claims is respectfully requested.

Respectfully submitted,

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